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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,817	06/23/2000	Brigido A. Borquez	3536P2177	7162
23504	7590	07/13/2005	EXAMINER	
WEISS & MOY PC			HAN, QI	•
4204 NORTH BROWN AVENUE				
SCOTTSDALE, AZ 85251			ART UNIT	PAPER NUMBER
			2654	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/599,817	BORQUEZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Qi Han	2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 and 11-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This communication is responsive to the applicant's amendment dated 11/15/2004. The Applicant(s) amended claim 1, and added new claims 11-14.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12, it recites a method, and at same time, also recites an apparatus with structural elements that recited as "the recording and transmitting system including: ..." (see the new added claim 12, on page 6 of the amendment), which results in claiming hybrid statutory classes in a single claim and being indefinite for failing to particularly point out which statutory class the recited claim belongs to. The claim will be interpreted as a method claim hereinafter, as best understood in view of the claim.

Regarding claims 13-14, they depend on claim 12 so that they inherit all the limitations of their parent claim(s), including the rejected limitation(s) above. Further, themselves recite more detailed limitation(s) only for the related structural elements, but not for any steps or sub-steps. As best understood in view of the claims, they will be interpreted as a method claim hereinafter, for consistency of the claim set.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (US 5,426,706), in view of Glenn et al. (US 6,098,034).

As per **claim 1**, Wood discloses remote simultaneous interpretation system (title), comprising:

“a human translator hearing words spoken in a source language” (Fig. 8 and col. 2, lines 64-66, ‘interpreter listens to the doctor, the patient or both’);

“said human translator simultaneously interpreting and translating said words in said source language into a target language” (Figs. 8-9, and col. 4, lines 4-6, ‘use simultaneous interpretation in the context of such doctor/patient oral communications); and

“said human translator verbally delivering a consecutive translation in real time relative to the step of hearing, the words spoken in the source language’ (Fig. 8 and col. 2, lines 45-50,

'enable a remotely located interpreter to simultaneously interpret the doctor's words to the patient in a language that the patient understands, and vice versa'.

But, Wood does not disclose "said human translator recording said words spoken in said source language utilizing a recording device capable of recording said words spoken in said source language; wherein said recording device further comprises means for playing back said words spoken in said source language substantially instantaneously". However, the feature is well known in the art as evidenced by Glenn who discloses language translator (title), comprising 'voice recorder' with functions of recording and replaying (play back) (col. 2, lines 35-54 and Figs. 1 and 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wood by providing a recording/playing back mechanism, as taught by Glenn, for the purpose of enabling the user (interpreter/translator) to attempt actual discourse (Glenn: col. 2, lines 53-54).

As per **claim 2** (depending on claim 1), Wood in view of Glenn further discloses "said recording device comprises a digital recorder", (Glenn: Fig. 3, 'record play IC' suggests using digital recording).

As per **claim 4** (depending on claim 1), Wood in view of Glenn further discloses "said recording device includes at least one earphone assembly coupled thereto and wherein said playing back of said words spoken in said source language is transmitted to said human translator through said at least one earphone assembly", (Wood: Fig. 8 and col. 2, lines 60, 'headset'; Glenn: Fig. 3, 'earphones').

As per **claim 5** (depending on claim 1), Wood in view of Glenn further discloses “said recording is in communication with at least one microphone located in a position that is remote from said recording device”, (Wood: col. 2, lines 59-60, ‘microphone’; Glenn: Fig. 3, ‘Mic 14’).

As per **claim 6** (depending on claim 5), Wood in view of Glenn further discloses “at least one remote microphone is in wireless communication with said recording device”, (Wood: col. 2, lines 659-60, ‘utilizing a remote interpretation station connected’ by ‘wireless... to microphones at a user station’).

As per **claim 11**, the rejection is based on the same reason described for claim 1, because the rejection for claim 1 covers the same or similar limitations of this claim, wherein the steps for processing the second spoken message are treated as the same functional steps for the first spoken message.

As per **claim 12**, as best understood in view of the rejection under 112, 2<sup>nd</sup> (see above), the rejection is based on the same reason described for claim 1, because the rejection for claim 1 covers the same or similar limitations of this claim.

As per **claim 13** (depending on claim 12), Wood in view of Glenn further discloses “the recording activator is a first recording activator and the playback activator is a first playback activator, the recording device further comprising a plurality of recording activators including the first recording activator and a plurality of playback activators including the first playback activator”, (Glenn: col. 4, lines 42-63, ‘recording function’, ‘activating momentary start/pause switch’, ‘reactivation’, ‘record and play back messages’, which read on the claim).

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5. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood and Glenn as applied to claims 1 and 12 above, and further in view of Cherny (US 6,219,646 B1).

As per **claim 3** (depending on claim 1), Wood in view of Glenn further does not expressly discloses “said recording device has a telephone input coupled thereto and wherein said telephone input permits said recording device to receive said words spoken in said source language over a telephone line and to transmit said words translated into said target language over said telephone line”. However, the feature is well known in the art as evidenced by Cherny who discloses methods and apparatus for translating between languages (title), comprising ‘translation system 100’ via ‘input system 102’ that ‘may include telephone 202 to receive voice inputs (words spoken in source language)’ (column 4, lines 1-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wood in view of Glenn by providing a telephone input to a recording system, as taught by Cherny, for the purpose of providing a near real-time conversation in different languages (Cherny: abstract).

As per **claim 14** (depending on claim 12), the rejection is based on the same reason described for claim 3, because the rejection for claim 3 covers the same or similar limitations of this claim.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood and Glenn as applied to claim 1 above, and further in view of well known prior art (MPEP 2144.03).

As per **claim 7** (depending on claim 1), Wood in view of Glenn does not expressly disclose “recording device includes means for adjusting the speed at which said words in said

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source language are played back". However, an official notice is taken that this feature is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that the recorder could be adjusted to play at a slower or faster speed because it would be user friendly allowing them to play back the recording with variable speed.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the

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QH/qh  
July 8, 2005



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SUPERVISORY PATENT EXAMINER